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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/518,642

03/03/2000

Grady Lynn Holt

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04/23/2004

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EXAMINER

LEUNG, JENNIFER A

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/518,642

Applicant(s)

HOLT, GRADY LYNN

Examiner

Jennifer A. Leung

Art Unit

1764

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: ---

Claim(s) objected to: ---

Claim(s) rejected: 1-7, 11, 12, 15, 17 and 18.

Claim(s) withdrawn from consideration: 8-10, 13, 14 and 16.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

CONTINUATION OF ITEM 2.

Applicant's proposed amendment to claim 1, which incorporates the structural limitation of "a septum within said cover" found in original claim 2, raises a new issue that requires further consideration and/or search, since this added limitation changes the breath of the claims which originally depended from claim 1 but not claim 2.

CONTINUATION OF ITEM 5.

The request for consideration has been considered, but it does not place the application in condition for allowance, for the same reasons as set forth in the Final Office Action. Also, Applicant argues (beginning on page 10, seventh paragraph),

"... amended claim 1 is clearly nonobvious over Ogle in view of Chaignay and De Santo, and further in view of Loper.

Applicants submit that the Loper's piston plug is not equivalent to the claimed septum. The "equivalence" of the two different components cannot be based on the fact that the components may be functional or mechanical equivalents - the equivalency must be recognized in the art.

In Loper, the piston plug operates to force a center sealing member into a lower compartment for the purpose of bringing a dry ingredient and a liquid ingredient into contact with each other. See Loper, col. 1, lines 19-22. Furthermore, the closure assembly of Loper is not described as suitable for handling of toxic, dangerous chemicals.

In contrast to Loper, the septum of the present invention allows for the safe sampling of toxic chemicals. The art has not recognized Loper's piston plug as an equivalent capable of allowing safe sampling of a container's contents."

The Examiner respectfully disagrees. The apparatus of Ogle employs a dispensing spout **16** having a fluid passage **18** for dispensing mixed fluid from the container **10**. Similarly, the apparatus of Loper employs a septum (i.e., piston plug **30**, penetrable by needle) for dispensing mixed fluid from the container **15**. It has been held that a prior art reference must either be in the

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field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). As both dispensing spout **16** and piston plug **30** are particularly concerned with enabling the mixed fluid within the containers to be dispensed to the outside of the containers, the Examiner maintains that it would have been obvious for one of ordinary skill in the art at the time the invention was made to substitute the septum for the dispensing spout of Ogle, since the substitution of known equivalent structures merely involves ordinary skill in the art, and the equivalency of a septum to a dispensing spout for enabling the removal of fluid from within a container to the outside of a container is well recognized in the art of fluid distribution.

Furthermore, nowhere in Loper is it taught that the piston plug **30** would not be suitable for handling of toxic or dangerous chemicals. All that is taught is that the plug is usable with liquids and solids, which does not limit the apparatus to non-toxic chemicals. Additionally, it is noted that the features upon which applicant relies (i.e., materials for the septum suitable for contact with a toxic chemical, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant additionally asserts (beginning on page 11, sixth paragraph),

"... the pleats of De Santo and the claimed compressible section are not functional or mechanical equivalents.

De Santo does not teach breaking high-strength frangible containers. It is a primary purpose of the present invention to break high-strength frangible containers safely contained in the compressible reactor. De Santo teaches pouring liquids into the container. Thus, one skilled in the art would not consider using the location of the pleats of De Santo in designing a compressible container that can break high-strength frangible

containers in a safe manner.

In addition, the pleats of De Santo are maintained in a “cocked and ready” position. If De Santo’s container is jarred or treated roughly, the contents of the container may be inadvertently mixed. The claimed compressible section is more rugged and can withstand rough treatment without inadvertently mixed the contents contained therein.

Since the prior art does not recognize the claimed compressible section and the pleats of De Santo as equivalent, one of ordinary skill in the art would not have been motivated to combine reference teachings in the manner asserted by the Examiner.”

The Examiner respectfully disagrees. Note that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, De Santo is merely provided as a secondary reference to illustrate the conventionality of locating pleats **14** at a location that differs from the pleats **32** as disclosed in the Ogle, for achieving the same results. Also, Applicant’s arguments regarding the capability of the apparatus for breaking “high-strength frangible containers” should instead be directed toward the primary reference of Ogle, if any exist, since De Santo is merely provided to illustrate the conventionality of shifting the location of parts. Both upper pleats **14** of De Santo and lower pleats **32** of Ogle, despite the differences in location, represent mechanical and functional equivalents, as both pleats are inherently capable of performing compression and expansion on the container, for actuating the projections formed in the covers of the containers (i.e., linear actuation of piercing element **34** in Ogle, or valve stem **38** of De Santo). Thus, one having ordinary skill in the art would have been properly motivated to combine the teachings of Ogle and De Santo to arrive at the claimed apparatus.

* * *

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Leung whose telephone number is (571) 272-1449. The examiner can normally be reached on 8:30 am - 5:30 pm M-F, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer A. Leung
April 21, 2004 